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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,498	12/14/2001	William E. Pence	3652/0K015	5619
7278	7590	07/13/2004	EXAMINER	
DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			HEWITT II, CALVIN L	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/017,498

Applicant(s)

PENCE ET AL.

Examiner

Calvin L Hewitt II

Art Unit

3621



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 31 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Status of Claims***

1. Claims 1-22 have been examined.

***Response to Arguments/Amendments***

2. The Applicant has amended claims 1 and 17-22 to include the limitation of transmitting, renewing, and updating a license file "transparently" which the Applicant asserts is synonymous to "without notifying a user" (an inaccurate association). Therefore, the cited prior art continues to read on the Applicant's claimed system. Specifically, Hortsman does not recite notifying a user during the transmitting, renewing or updating process (column 4, lines 12-38). The Applicant ([www.webopedia.com](http://www.webopedia.com)) defines "transparently" as

Invisible. In computer software, an action is transparent if it takes place without any visible effect. Transparency is usually considered to be a good characteristic of a system because it shields the user from the system's complexity

Microsoft Press Computer Dictionary defines "transparent" as

Pertaining to, or characteristic of a device, function, or part of a program that works so smoothly and easily that it is invisible to the user. For example, the ability of one application to use files created by another is transparent if the user encounters no difficulty in opening, reading, or using the second program's files or does not even know the use is occurring.

Therefore, contrary to the Applicant's opinion, "transparently" does not mean *without notifying the user*.

On the other hand, Hortsman teaches transmitting and renewing "transparently" (webopedia, Microsoft Press) as the user is shielded from the system's complexity. For example, users are shielded from the underlying system (i.e. interaction between the applications running in conjunction with or on the user's relicense manager, the publisher's site and license server) complexity regarding the checking of relicensing policies, connecting to the license clearinghouse, connecting to the publisher, installing the software and updating a license certificate (column 4, lines 12-38). The Applicant is of the opinion that this is not the case. However, to reach this conclusion the Applicant relies on a definition of "transparent" that is outside the understanding of one of ordinary skill and contrary to the established definition (webopedia.com, Microsoft Press Dictionary). The definition (webopedia.com, Microsoft Press Dictionary) of "transparent" to one of ordinary skill would not exclude a user from having knowledge of a license (column/line 3/65-4/5). A proper application of the term would result in a user having knowledge of the function of a license but not the *how*, (e.g. programs, calls, functions) on a system or computational level, a digital license worked, as the user is blind to its various calls, parameters, variables, routines and subroutines. Notice the Applicant did not claim a system

where a license is downloaded and *maintained* on the user's system in secret, or a hidden license. Nor does the Applicant have support for such a limitation, because as in the Hortsmann system, a user in the Applicant's teaching has knowledge of the license (figures 2A, 2B and 3B). Finally, the Examiner would like to further point out that to one of ordinary skill modern computer processing is inherently transparent as it [modern computing] comprises GUIs, "point and click" access, migration away from the "prompt", "high level" programs, scripting, internet, etc..

The Examiner maintains the rejection.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters transparently" (claims 1, 19, 20 and 22) "update said license file parameter transparently" (claims 17 and 18).

Claims 2-18 are also rejected as they depend from claim 1.

5. Claims 1-20 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters transparently" (claims 1, 19, 20 and 22) "update said license file parameter transparently" (claims 17, 18 and 22). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "transparently", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content. In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-18 are also rejected as they depend from claim 1.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 and 22 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The Applicant's Specification is silent regarding the following: "renewing the parameters transparently" (claims 1, 19, 20 and 22) "update said license file parameter transparently" (claims 17, 18 and 22). Further the Specification does not provide one of ordinary skill with the necessary data for implementing the Applicant's system regarding transmitting a license file "transparently", particularly in light of the Applicant's teachings which suggest to one of ordinary skill that the user has or explicit knowledge of the existence or at least knowledge of the functionality of the license with respect to the content. In addition it is not clear to one of ordinary skill whether the user never has knowledge of the license, is not informed of the specific download, or somewhere in-between.

Claims 2-18 are also rejected as they depend from claim 1.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-7 and 10-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 in view of Hortsman, U.S. Patent No. 6,009,401.

As per claims 1-7 and 10-22, Rivera et al. licensing system comprising:

- A processor and memory storing instructions for controlling the processor (figures 1; column/line 4/54-6/2)
- creating a license file having one or more parameters (column 8, lines 32-34)
- transmitting content from a provider system to a user (column/line 5/52-6/2)
- comparing license parameters to determine whether or not a user is allowed to access content and renewing parameters in the license file to



allow continued access to the content by the user in accordance with license parameters (column/line 8/35-9/14)

- storing license file parameters using a subscription system (figure 3)
- storing downloaded content on a user database (figure 3; column/line 5/52-6/2)
- a subscription management service operable to monitor and store one or more license file parameters (figure 3)

Rivera et al. also teach client application for receiving user input and providing user input to communication application, license storage and content storage, as it would have been obvious to combine the server that stores the monitoring routine with the server that disseminates the software (figures 3-5B; column/line 5/52-6/57). However, Rivera et al. do not explicitly recite transmitting a license file to a user. Hortsmann teaches a provider system transparently transmitting a license file that contains user technical information and type of content, for storage on a user system (figures 1 and 2; column/line 3/43-4/11). Hortsmann also teaches a license file stored on a license server and client system (figures 1 and 2), a license server generating the license file for a user (column/line 3/65-4/11), storing license file parameters in a registry (column/line 3/43-4/11).

Therefore, it is at least obvious that the file was created and transferred via the license server. Rivera et al. do not explicitly recite disseminating content with license. On the other hand, Rivera et al. teach disseminating content using a server (column/line 5/52-6/2), while Hortsmann teaches delivering content with license offline (figure 3) hence it would have been obvious to one of ordinary skill to distribute the content with the license electronically. Therefore it would have been obvious to one of ordinary skill to combine the teachings of Rivera et al. and Hortsmann in order to include license terms such as the number of computers allowed to access software (i.e. number of licenses), access license data stored on a user system ('401, column 3, lines 44-51), determine whether a customer is in compliance with the license terms, offer the customer the opportunity to come under license compliance without interrupting the customer's business and update the license file accordingly (e.g. purchase extra licenses) ('786, figures 5A-B; column 8, lines 35-47; '401, column 3, lines 44-51).

9. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivera et al., U.S. Patent No. 6,056,786 and Hortsmann, U.S. Patent No. 6,009,401 as applied to claim 1 in further view of Johnson et al., U.S. Patent No., 5,023,907.

As per claims 8 and 9, Rivera et al. teach a license compliance monitoring system (figure 3) while, Hortsmann teaches transmitting a license file to a user

and without notifying said user (figures 1 and 2; column/line 3/43-4/11). However, neither reference explicitly recites creating individual license files for individual content items and one license file for a plurality of items. Johnson et al. teach a licensing system that creates individual license files for individual content items and one license file for a plurality of items (figure 2). Therefore, it would have been obvious to combine the systems of Rivera et al., Hortsman and Johnson et al. in order to permit an end-user to more accurately account for licensed products ('907, figure 2).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Calvin Loyd Hewitt II whose telephone number is (703) 308-8057. The Examiner can normally be reached on Monday-Friday from 8:30 AM-5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James P. Trammell, can be reached at (703) 305-9768.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
c/o Technology Center 2100  
Washington, D.C. 20231

or faxed to:

(703) 305-7687 (for formal communications intended for entry and after-final communications),

or:

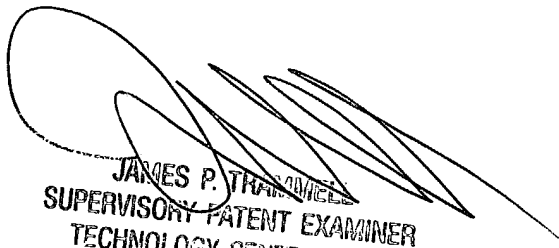
(703) 746-5532 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, 7th Floor Receptionist.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

Calvin Loyd Hewitt II

December 9, 2003



JAMES P. THAMMACHARN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600